

REMARKS

This is a full and timely response to the outstanding non-final Office Action mailed October 5, 2004. Upon entry of the amendments in this response, claims 1 – 25 remain pending. More specifically, Applicant amends claims 1, 6, 9, 13, 14, and 17. Reconsideration and allowance of the application and presently pending claims are respectfully requested. In addition, Applicant does not intend to make any admissions regarding any other statements in the Office Action that is not explicitly referenced in this response

I. Rejections Under 35 U.S.C. §102

A proper rejection of a claim under 35 U.S.C. §102 requires that a single prior art reference disclose each element of the claim. *See, e.g., W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303, 313 (Fed. Cir. 1983).

A. Claim 1 is Patentable Over *Del Sordo*

The Office Action indicates that claim 1 stands rejected under 35 U.S.C. §102(e) as being anticipated by U.S. patent number 6,718,374 to Del Sordo, et al. (“*Del Sordo*”). Applicant respectfully traverses this rejection on the grounds that the *Del Sordo* reference does not disclose, teach, or suggest all of the claimed elements. The Office Action recites that “the claimed ‘retrieving a service group table from a signal on the transmission medium,’ ‘retrieving tuning information from the service group table...’ and tuning to a frequency retrieved for the tuning inform[ation]’ are met by Processor 321 of Set-Top Terminal (STT) 300 ‘decoder’ (FIGs. 3, 4, col. 3, line 62 – col. 4, line 9 and col. 8, lines 30 – 50), note that Cable Television Headend (CATV-HE) broadcasts different or a variety of programming objects or services, such as TV

channels, Pay-per-view (PPV), VOD, Internet access, Email, etc., ‘service group’ of channels containing ‘tuning information...’ (col. 1, lines 33 – 59)...” (item 2, p. 2 – 3).

Applicant respectfully disagrees with this analysis. First, nowhere in any excerpt cited by the Office Action is there any mention of Processor 321 performing anything relating to “retrieving a service group table from a signal on the transmission medium...retrieving tuning information from the service group table...[or] tuning to a frequency retrieved for the tuning information.” Second, *Del Sordo* recites that “[t]he set-top box (300) will have a **table of carrier frequencies** which the headend may be broadcasting a control channel of data and programming” (col. 8, lines 36 – 38). However, claim 1 recites a method comprising “retrieving a **service group table** from a signal on the transmission medium...” Clearly, a table of carrier frequencies is vastly different than a service group table.

Finally, Applicant amends claim 1 to include “...retrieving a service group table from a signal on the transmission medium, wherein the service group table includes a plurality of service group identifications and associated information for determining a service group to which the decoder belongs...” Applicant asserts that this amendment clearly distinguishes claim 1 from *Del Sordo*. For at least these reasons, claim 1 is patentable over *Del Sordo*.

B. Claim 6 is Patentable Over *Del Sordo*

The Office Action indicates that claim 6 stands rejected under 35 U.S.C. §102(e) as being anticipated by U.S. patent number 6,718,374 to Del Sordo, et al. (“*Del Sordo*”). Applicant respectfully traverses this rejection on the grounds that the *Del Sordo* reference does not disclose, teach, or suggest all of the claimed elements. The Office Action recites that:

the claimed ‘creating, at the headend, a *service group table* for the subscriber television system,’ ‘causing to be transmitted from the headend, the *service group table...*’ are met by Cable Television (CATV) Headend (FIGs. 3, 4, col. 3, line 62 – col. 4, line 9 and col. 8, lines 30 – 50), which creates and broadcasts a service group table of different or variety of programming objects or services, such as: TV channels, Pay-per-view (PPV) VOD, Internet Access, Email, etc., ‘service group’ (col. 1, lines 33 – 59) to different classes of STT(S) 300 ‘decoders,’ where STT(S) 300 receives a table of carrier frequencies... (item 2, p. 5).

Applicant respectfully disagrees with this analysis. First, nowhere in any excerpt cited by the Office Action is there any mention of CATV headend performing anything relating to “creating, at the headend, a service group table for the subscriber television system... causing to be transmitted from the headend, the service group table.” Second, *Del Sordo* recites that “[t]he set-top box (300) will have a *table of carrier frequencies* which the headend may be broadcasting a control channel of data and programming” (col. 8, lines 36 – 38). However, claim 6 recites a method comprising “creating, at the headend, a *service group table* for the subscriber television system...” Clearly, a table of carrier frequencies is vastly different than a service group table.

Finally, Applicant amends claim 6 to include “...creating, at the headend, a service group table for the subscriber television system, wherein the service group table includes a plurality of service group identifications and associated information for determining a service group to which the decoder belongs...” Applicant asserts that this amendment clearly distinguishes claim 6 from *Del Sordo*. For at least these reasons, claim 6 is patentable over *Del Sordo*. For at least these reasons, claim 6 is patentable over *Del Sordo*.

C. Claim 9 is Patentable Over *Del Sordo*

The Office Action indicates that claim 9 stands rejected under 35 U.S.C. §102(e) as being anticipated by U.S. patent number 6,718,374 to Del Sordo, et al. (“*Del Sordo*”). Applicant respectfully traverses this rejection on the grounds that the *Del Sordo* reference does not disclose, teach, or suggest all of the claimed elements. The Office Action recites that “the claimed ‘a means for creating a service group table and a transmitter for transmitting a ***service group table***’ is met by Cable Television (CATV) Headend (FIGs. 3, 4, col. 3, line 62 – col. 4, line 9 and col. 8, lines 30 – 50), which creates and stores and CATV Headend channel modulators (CATV-CH-MODs), modulates the signals within the channels and transmits a service group table of different or variety of programming objects or services...” (item 2, p. 6 – 7).

Applicant respectfully disagrees with this analysis. First, nowhere in any excerpt cited by the Office Action is there any mention of CATV Headend performing anything relating to “a means for creating a service group table and a transmitter for transmitting a service group table.” Second, *Del Sordo* recites that “[t]he set-top box (300) will have a ***table of carrier frequencies*** which the headend may be broadcasting a control channel of data and programming” (col. 8, lines 36 – 38). However, claim 9 recites a modulator comprising “a means for creating a ***service group table***...” Clearly, a table of carrier frequencies is vastly different than a service group table.

Finally, Applicant amends claim 9 to include “...a means for creating a service group table, wherein the service group table includes a plurality of service group identifications and associated information for determining a service group to which the decoder belongs...”

Applicant asserts that this amendment clearly distinguishes claim 9 from *Del Sordo*. For at least

these reasons, claim 9 is patentable over *Del Sordo*. For at least these reasons, claim 9 is patentable over *Del Sordo*.

D. Claim 13 is Patentable Over *Del Sordo*

The Office Action indicates that claim 13 stands rejected under 35 U.S.C. §102(e) as being anticipated by U.S. patent number 6,718,374 to Del Sordo, et al. (“*Del Sordo*”). Applicant respectfully traverses this rejection on the grounds that the *Del Sordo* reference does not disclose, teach, or suggest all of the claimed elements. The Office Action recites that “the claimed ‘means for retrieving tuning information from the service group table...’ [is] met by Processor 321 of Set Top Terminal (STT) 300 ‘decoders’ (FIGs. 3, 4, col. 3, line 62 – col. 4, line 9 and col. 8, lines 30 – 50)...” (item 2, p. 8 – 9).

Applicant respectfully disagrees with this analysis. First, nowhere in any excerpt cited by the Office Action is there any mention of Processor 321 performing anything relating to “means for determining, from the *service group table* the service group associated with at least one frequency, if the valid signal is present on the at least one frequency.” Second, *Del Sordo* recites that “[t]he set-top box (300) will have a *table of carrier frequencies* which the headend may be broadcasting a control channel of data and programming” (col. 8, lines 36 – 38). However, claim 13 recites a decoder comprising “retrieving tuning information from the service group table...” Clearly, a table of carrier frequencies is vastly different than a service group table. Finally, *Del Sordo* fails to disclose, teach or suggest any “means for determining, from the service group table, the service group associated with the at least one frequency...” (claim 13).

Finally, Applicant amends claim 13 to include “...a tuner for tuning to a signal received from a transmission medium, wherein the service group table includes a plurality of service

group identifications and associated information for determining a service group to which the decoder belongs...” Applicant asserts that this amendment clearly distinguishes claim 13 from *Del Sordo*. For at least these reasons, claim 13 is patentable over *Del Sordo*. For at least these reasons, claim 13 is patentable over *Del Sordo*.

E. Claim 17 is Patentable Over *Del Sordo*

The Office Action indicates that claim 17 stands rejected under 35 U.S.C. §102(e) as being anticipated by U.S. patent number 6,718,374 to Del Sordo, et al. (“*Del Sordo*”). Applicant respectfully traverses this rejection on the grounds that the *Del Sordo* reference does not disclose, teach, or suggest all of the claimed elements. The Office Action recites that:

the claimed ‘means for causing to be stored the database of a service group for each of the plurality of decoders,’ means for causing the creation of service group table for the subscriber television, ‘means for causing the headend to transmit the **service group table** to at least one of the plurality of the decoders...’ are met by Cable Television (CATV) Headend (FIGs. 3, 4, col. 3, line 62 – col. 4, line 9 and col. 8, lines 30 – 50), which creates, stores, and transmits to at least one of a plurality of decoders a service group table of different or a variety of programming objects or services... (item 2, p. 10).

Applicant respectfully disagrees with this analysis. First, nowhere in any excerpt cited by the Office Action is there any mention of CATV Headend performing anything relating to “means for causing to be stored the database of a service group for each of the plurality of decoders... means for causing the creation of service group table for the subscriber television... means for causing the headend to transmit the service group table to at least one of the plurality of the decoders...” Second, *Del Sordo* recites that “[t]he set-top box (300) will have a **table of carrier frequencies** which the headend may be broadcasting a control channel of data and programming” (col. 8, lines 36 – 38). However, claim 17 recites a method comprising “‘means

for causing to be stored the database of a service group for each of the plurality of decoders,’ means for causing the creation of service group table for the subscriber television, ‘means for causing the headend to transmit the **service group table** to at least one of the plurality of the decoders...” Clearly, a table of carrier frequencies is vastly different than a service group table.

Finally, Applicant amends claim 17 to include “...means for causing the creation of a service group table for the subscriber television system, wherein the service group table includes a plurality of service group identifications and associated information for determining a service group to which the decoder belongs...” Applicant asserts that this amendment clearly distinguishes claim 17 from *Del Sordo*. For at least these reasons, claim 17 is patentable over *Del Sordo*. For at least these reasons, claim 17 is patentable over *Del Sordo*.

E. Claim 19 is Patentable Over *Del Sordo*

The Office Action indicates that claim 19 stands rejected under 35 U.S.C. §102(e) as being anticipated by U.S. patent number 6,718,374 to Del Sordo, et al. (“*Del Sordo*”). Applicant respectfully traverses this rejection on the grounds that the *Del Sordo* reference does not disclose, teach, or suggest all of the claimed elements. The Office Action recites that:

the claimed ‘means for storing and updating a database of frequencies, related transport stream identities, and associated services group identities for a plurality of modulators,’ means for causing the creation of a **modulator tuning table** for the subscriber television’ and ‘means for causing to be transmitted, for the headend, the **modulator tuning table** via the transmission medium at least one of the set of audit designated decoders,’ are met CATV Headend channel modulators (CATV-HE-MOD) (FIGs. 3, 4, col. 3, line 62 – col. 4, line 9 and col. 8, lines 30 – 50), note that CATV Headend stores and updates a database of frequencies, related transport stream identities and associated services group identities for each of CATV-HE-MODs, audits at least one STT 300 or subset of STTS 30 and customizes specific group of services to a specific or subset(s) of STT(S) 300 ‘**set of audit designated decoders**’ (col. 5, lines 3 – 13 and col. 11, 5 – 24)...” (item 2, p. 11 –12).

Applicant respectfully disagrees with this analysis. First, nowhere in any excerpt cited by the Office Action is there any mention of CATV Headend performing anything relating to “means for storing and updating a database of frequencies, related transport stream identities, and associated services group identities for a plurality of modulators... means for causing the creation of a modulator tuning table for the subscriber television... [and] means for causing to be transmitted, for the headend, the modulator tuning table via the transmission medium at least one of the set of audit designated decoders.” Second, *Del Sordo* refers neither to ***audit designated decoders*** nor a ***modular tuning table***, as recited in claim 19. For at least these reasons, claim 19 is patentable over *Del Sordo*.

F. Claim 22 is Patentable Over *Del Sordo*

The Office Action indicates that claim 22 stands rejected under 35 U.S.C. §102(e) as being anticipated by U.S. patent number 6,718,374 to Del Sordo, et al. (“*Del Sordo*”). Applicant respectfully traverses this rejection on the grounds that the *Del Sordo* reference does not disclose, teach, or suggest all of the claimed elements. The Office Action recites that:

the claimed ‘establishing, in the headend, a ***modulator tuning table*** listing available subscriber television system frequency associated with the plurality of modulators,’ transmitting the ***modulator tuning table*** from the headend on the transmission medium to at least one of the set of ***audit designated decoders***’ are met by CATV-HE (FIGs. 3, 4, col. 1, lines 33 – 53 and col. 3, line 62 – col. 4, line 9)... The claimed ‘retrieving the ***modulator tuning table*** at the at least one ***audit designated decoder***,’ ‘tuning, at least one ***audit designated decoder***, to each frequencies listed in the ***modulator tuning table***, and if a valid signal is detected, retrieving an associated Motion picture...’ is met by Set Top Terminal (STT) 300 (col. 5, lines 26 – 57, col. 7, lines 53 – 3 and col. 8, lines 30 – 50)... (item 2, p. 14 – 15).

Applicant respectfully disagrees with this analysis. First, nowhere in any excerpt cited by the Office Action is there any mention of CATV Headend performing anything relating to “establishing, in the headend, a ***modulator tuning table*** listing available subscriber television system frequency associated with the plurality of modulators... transmitting the ***modulator tuning table*** from the headend on the transmission medium to at least one of the set of ***audit designated decoders***.” Second, *Del Sordo* refers neither to ***audit designated decoders*** nor a ***modular tuning table***, as recited in claim 22. For at least these reasons, claim 22 is patentable over *Del Sordo*.

B. Claims 2 – 5, 7 – 8, 11 – 12, 14 – 16, 18, 20 – 21, and 23 – 25 are Patentable Over *Del Sordo*

In addition, dependent claims 2 – 5 are believed to be allowable for at least the reason that these claims depend from allowable independent claim 1. Dependent claims 7 – 8 are believed to be allowable for at least the reason that they depend from allowable independent claim 6. Dependent claims 11 – 12 are believed to be allowable for at least the reason that they depend from allowable independent claim 9. Dependent claims 14 – 16 are believed to be allowable for at least the reason that they depend from allowable independent claim 13. Dependent claim 18 is believed to be allowable for at least the reason that they depend from allowable independent claim 17. Dependent claims 20 – 21 are believed to be allowable for at least the reason that they depend from allowable independent claim 19. Finally, dependent claims 23 – 25 are believed to be allowable for at least the reason that they depend from allowable independent claim 22. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988).

II. Rejections Under 35 U.S.C. §103 – Claim 10 is Patentable over *Del Sordo*, further in view of *Yamashita*

In order for a claim to be properly rejected under 35 U.S.C. §103, the teachings of the prior art reference must suggest all features of the claimed invention to one of ordinary skill in the art. *See, e.g., In re Dow Chemical*, 837 F.2d 469, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988); *In re Keller*, 642 F.2d 413, 208 U.S.P.Q. 871, 881 (C.C.P.A. 1981). Further, “[t]he PTO has the burden under section 103 to establish a prima facie case of obviousness. It can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.” *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988).

Dependent claim 10 is believed to be allowable for at least the reason that it depends from allowable independent claim 9. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988).

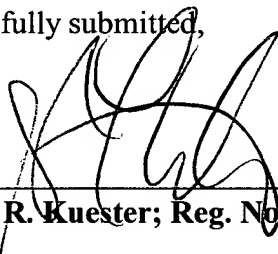
Cited Art Made of Record

The cited art made of record has been considered, but is not believed to affect the patentability of the presently pending claims.

CONCLUSION

In light of the foregoing amendments and for at least the reasons set forth above, Applicant respectfully submits that all objections and/or rejections have been traversed, rendered moot, and/or accommodated, and that the now pending claims 1 – 25 are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,

A handwritten signature in black ink, appearing to be 'JK', is written over a horizontal line.

Jeffrey R. Kuester; Reg. No. 34,367